



Patent
Attorney's Docket No. 025265-155

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Brandon YIP et al.

Application No.: 09/403,608

Filed: October 25, 1999

For: COATED SUNGLASS LENS

PCT Legal Office

Leonard E. Smith
Anthony Smith

SECOND RENEWED PETITION UNDER 37 C.F.R. § 1.497(d)

Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Sir:

In response to the Decision on Petition Under 37 C.F.R. § 1.497(d) issued June 20, 2001 in connection with the above-referenced application, enclosed is a copy of an Assignment, filed for recordation in the U.S. Patent and Trademark Office on November 2, 2001.

In the decision, a copy of which is attached hereto, it is noted that Applicants have satisfied three of the four requirements for a submission under 37 C.F.R. §1.497(d). The only outstanding requirement - requirement (4) - has not so far been satisfied because the previously filed assignment document "fails to sufficiently identify the application."

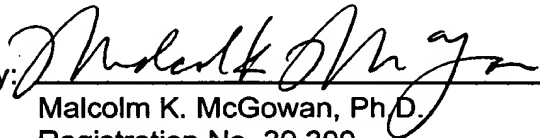
Accordingly, the assignment documents submitted herewith identify the application by Serial Number and filing date.

In view of the submission of these documents, Applicants submit that all of the requirements of 37 C.F.R. §1.297(d) have been met.

Correction of the inventorship of the instant applicant, by adding Randy Lee Gove as an inventor, is respectfully requested.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 
Malcolm K. McGowan, Ph.D.
Registration No. 39,300

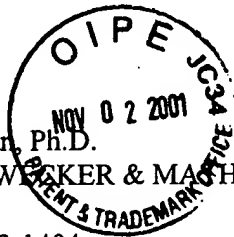
P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: November 2, 2001



UNITED STATES PATENT AND TRADEMARK OFFICE

JUN 20 2001



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www.uspto.gov

Malcolm K. McGowan, Ph.D.
BURNS, DOANE, SWICKER & MACHIS
Post Office Box 1404
Alexandria, VA 22313-1404

In re Application of
YIP et al.
Application No.: 09/403,608
PCT No.: PCT/AU98/00868
Int. Filing Date: 18 October 1998
Priority Date: 21 October 1997
Attorney Docket No.: 025265-155
For: COATED SUNGLASS LENS

DECISION ON REQUEST
UNDER 37 CFR 1.497(d)

This is a decision on "Renewed Petition Under 37 CFR 1.48(a)," which is being treated as a request under 37 CFR 1.497(d) filed 12 March 2001 requesting the addition of fifth joint inventor, Randy Lee Gove. Applicants' previous petition was dismissed in a decision dated 12 December 2000 because applicants did not submit the written consent of the assignee.

On 12 March 2001, applicant filed the present petition.

DISCUSSION

A submission under 37 CFR 1.497(d) to correct an error in naming inventorship requires:

- (1) a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;
- (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.497(a);
- (3) the fee set forth in 37 CFR 1.17(i); and
- (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

Applicants' have satisfied items (1), (2) and (3).

In regard to item (4) above, applicants have provided a "Consent of Assignee to Change in Inventorship Pursuant to 37 CFR 1.48(a)(4)." However, the assignments provided does not establish ownership to the application as they fail to sufficiently identify the application. See 37 CFR 3.21, which states:

An assignment relating to a patent must identify the patent by the patent number. An assignment relating to a national patent application must identify the national patent application by the application number (consisting of the series code and the

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JWP/SCM/MMCM

Rec. Reconsideration Due 8/20/01

serial number, e.g., 07/123,456). An assignment relating to an international patent application which designates the United States of America must identify the international application by the international application number (e.g., PCT/US90/01234). If an assignment of a patent application filed under Section 1.53(b) is executed concurrently with, or subsequent to, the execution of the patent application, but before the patent application is filed, it must identify the patent application by its date of execution, name of each inventor, and title of the invention so that there can be no mistake as to the patent application intended. If an assignment of a provisional application under Section 1.53(c) is executed before the provisional application is filed, it must identify the provisional application by name of each inventor and title of the invention so that there can be no mistake as to the provisional application intended.

The assignments do not identify this application and the dates of execution are either wrong or not included. Therefore, applicants have not satisfied Item 4.

CONCLUSION

The renewed request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.


Applicant is given **TWO MONTH** from the mailing date of this decision to submit any desired request for reconsideration. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)." No additional petition fee is required.

Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



Boris Milef
PCT Legal Examiner
PCT Legal Office



Anthony Smith
Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6314
Facsimile: (703) 308-6459



RECORDATION FORM COVER SHEET
PATENTS ONLY

DEPARTMENT OF COMMERCE
Patent and Trademark Office

Attorney's Docket No. 025265-155

To the Honorable Commissioner of Patents and Trademarks. Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

Brandon YIP, Colin JAMES, Frank Arnold SAMSON,
Brian Douglas ADAMS, and Randy Lee GOVE

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name

Other: _____

Execution Date: Sept. 24, 2001; Sept. 24, 2001, Sept. 24,
2001; Sept. 24, 2001; Oct. 2, 2001 respectively

2. Name and address of receiving party(ies):

Name: Sola International Holdings Ltd.

Address: Sheriffs Road, Lonsdale

South Australia 5160

Australia

Additional name(s) & address(es) attached? ☐ Yes ☒ No

COPY

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No.(s)

09/403,608

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Samuel C. Miller, III, Esq.

Address: BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404

Alexandria, Virginia 22313-1404

6. Total number of applications and patents involved: _____

7. Total fee (37 CFR § 3.41): \$ 40.00

☒ Enclosed

☒ Authorized to be charged to deposit account, if necessary

8. Deposit account number:

02-4800

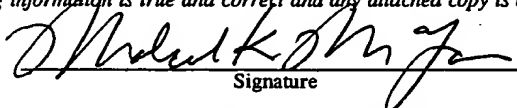
DO NOT USE THIS SPACE

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Malcolm K. McGowan, Ph.D., Reg. # 39,300

Name of Person Signing


Signature

November 2, 2001

Date

Total number of pages including cover sheet, attachments, and document: 3

COPY

Mail documents to be recorded with required cover sheet information to:

Commissioner of Patents and Trademarks
Box Assignments
Washington, D.C. 20231

COPY

ASSIGNMENT

(JOINT)

THIS ASSIGNMENT, by BRANDON YIP, COLIN JAMES, FRANK ARNOLD SAMSON, BRIAN DOUGLAS ADAMS, and RANDY LEE GOVE, residing at UNIT 3, 4 STIRLING ROAD, BLACKWOOD SOUTH AUSTRALIA 5051 AUSTRALIA; UNIT 2, HILLVIEW CRESCENT, SOUTH BRIGHTON, SOUTH AUSTRALIA 5048, AUSTRALIA; 2632 COSGROVE ROAD, STRATHALBYN SOUTH AUSTRALIA 5255, AUSTRALIA; 39 DARWENDALE STREET, HUNTFIELD HEIGHTS, SOUTH AUSTRALIA 5163, AUSTRALIA and 1202 MAPLE DRIVE, ROHNERT PARK, CALIFORNIA 94928, UNITED STATES OF AMERICA (hereinafter referred to as "the Assignors"), respectively, witnesseth:

WHEREAS, the Assignors have invented certain new and useful improvements in COATED SUNGLASS LENS set forth in an application for Letters Patent of the United States,

- (1) ☐ which is a provisional application
 - (a) ☐ to be filed herewith; or
 - (b) ☐ bearing Application No. __, and filed on __; or
- (2) ☒ which is a non-provisional application
 - (a) ☐ having an oath or declaration executed on even date herewith prior to filing of application;
 - (b) ☐ bearing Application No. 09/403,608, and filed on OCTOBER 25, 1999; or
 - (c) ☐ to be filed; and

WHEREAS, SOLA INTERNATIONAL HOLDINGS LTD, a corporation duly organized under and pursuant to the laws of AUSTRALIA and having its principal place of business at SHERIFFS ROAD, LONSDALE, SOUTH AUSTRALIA 5160, AUSTRALIA (hereinafter referred to as "the Assignee"), is desirous of acquiring the entire right, title, and interest in and to said inventions, the right to file applications on said inventions and the entire right, title and interest in and to any applications, including provisional applications for Letters Patent of the United States or other countries claiming priority to said application, and in and to any Letters Patent or Patents, United States or foreign, to be obtained therefor and thereon.

NOW, THEREFORE, in consideration of One Dollar (\$1.00) and other good and sufficient consideration, the receipt of which is hereby acknowledged, the Assignors have sold, assigned, transferred, and set over, and by these presents do sell, assign, transfer, and set over, unto the Assignee, its successors, legal representatives, and assigns the entire right, title, and interest in and to the above-mentioned inventions, the right to file applications on said inventions and the entire right, title and interest in and to any applications for Letters Patent of the United States or other countries claiming priority to said applications, and any and all Letters Patent or Patents of the United States of America and all foreign countries that may be granted therefor and thereon, and in and to any and all applications claiming priority to said applications, divisions, continuations, and continuations-in-part of said applications, and reissues and extensions of said Letters Patent or Patents, and all rights under the International Convention for the Protection of Industrial Property, the same to be held and enjoyed by the Assignee, for its own use and behalf and the use and behalf of its successors, legal representatives, and assigns, to the full end of the term or terms for which Letters Patent or Patents may be granted as fully and entirely as the same would have been held and enjoyed by the Assignors had this sale and assignment not been made;

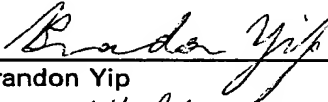
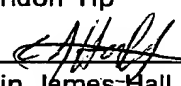
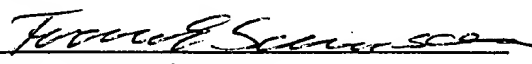

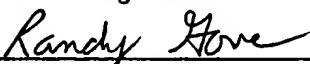
AND for the same consideration, the Assignors hereby covenant and agree to and with the Assignee, its successors, legal representatives, and assigns, that, at the time of execution and delivery of these presents, the Assignors are the sole and lawful owners of the entire right, title, and interest in and to the inventions set forth in said applications and said applications, including provisional applications, above-mentioned, and that the same are unencumbered, and that the

Assignors have good and full right and lawful authority to sell and convey the same in the manner herein set forth;

AND for the same consideration, the Assignors hereby covenant and agree to and with the Assignee, its successors, legal representatives, and assigns that the Assignors will, whenever counsel of the Assignee, or the counsel of its successors, legal representatives, and assigns, shall advise that any proceeding in connection with said inventions or said applications for Letters Patent or Patents, or any proceeding in connection with Letters Patent or Patents for said inventions in any country, including interference proceedings, is lawful and desirable, or that any application claiming priority to said application, division, continuation, or continuation-in-part of any applications for Letters Patent or Patents, or any reissue or extension of any Letters Patent or Patents to be obtained thereon, is lawful and desirable, sign all papers and documents, take all lawful oaths, and do all acts necessary or required to be done for the procurement, maintenance, enforcement, and defense of Letters Patent or Patents for said inventions, without charge to the Assignee, its successors, legal representatives, and assigns, but at the cost and expense of the Assignee, its successors, legal representatives, and assigns;

AND the Assignors hereby authorize and request the attorneys of BURNS, DOANE, SWECKER & MATHIS, L.L.P. of Alexandria, Virginia to insert in the spaces provided above the filing date, application number, and attorney docket number of said application when known.

AND the Assignors hereby request the Commissioner of Patents to issue any and all said Letters Patent of the United States to the Assignee as the Assignee of said inventions, the Letters Patent to be issued for the sole use and behalf of the Assignee, its successors, legal representatives, and assigns.

Date <u>24/9/01</u>	Signature of Assignor <u></u> Brandon Yip
Date <u>24/9/01</u>	Signature of Assignor <u></u> Colin James Hall
Date <u>24/9/01</u>	Signature of Assignor <u></u> Frank Arnold Samson
Date <u>24/09/01</u>	Signature of Assignor <u></u> Brian Douglas Adams
Date <u>2/10/01</u>	Signature of Assignor <u></u> Randy Lee Gove